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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/060,907      | 01/29/2002  | Hiroshi Ogino        | FS.F5191US1C        | 1686             |

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EXAMINER

SWINEHART, EDWIN L

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                |
|------------------------------|-----------------|----------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |
|                              | Examiner        | Group Art Unit |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s) 1-15 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-15 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Notice of Reference(s) Cited, PTO-892
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Interview Summary, PTO-413
- Notice of Informal Patent Application, PTO-152
- Other \_\_\_\_\_

**Office Action Summary**

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## DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,341,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations now claimed are within the Patented claims, and therefore the present claims are not patentable thereover.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11,12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mondek.

Mondek et al. teaches an outboard motor including a tubular steering shaft/kingpin **67**, open at the bottom, since the shift mechanism passes therethrough, and a swivel bracket **55**, as is old and well known in the art. Mondek et al. further teaches a means **117** and **119** for inhibiting the influx of water into the bottom end of the steering shaft, and inherently protecting the mounts **73** since such covers same.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondek in view of Shiomi et al.

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Mondek fails to disclose the old and well known claimed relationship of the spacing of the bottom of the hollow steering shaft and drive unit, such being shown in figure 3 of Shiomi et al.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the propulsion unit of Mondek with the old and well known arrangement of a gap between steering shaft and drive unit as shown by Shiomi et al.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondek in view of Shigedomi et al.

Mondek disclose what is believed to be a generally old and well known mount arrangement at 73, but fails to disclose the particulars thereof.

Shigedomi et al. illustrates a typical outboard mounting system, including a hub member mounted to the steering shaft and the drive unit via a rubber vibration isolating mount. The drive unit of Shigedomi et al. can be seen as extending beneath the hollow steering shaft such that a gap is formed thereinbetween.

It would have been obvious to one of ordinary skill in the art at the time of the invention to attach the drive unit of Mondek to the steering shaft via a hub member and rubber mount as taught by Shigedomi et al.

Such a combination would have been desirable at the time of the invention was made so as to provide for isolation of the drive unit from the boat, as is known in the art.

8. Papers relating to this application may be submitted to Technology Center 3600 by facsimile transmission. The submission of such papers by facsimile transmission must comply with

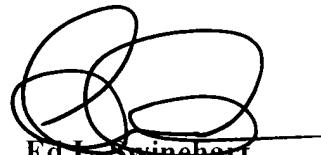
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the notice published in the Official Gazette, **1096 OG 30** (November 15, 1989). The Fax Center number is (703)-872-9326.

9. Any inquiry concerning this communication should be directed to Ed L. Swinehart whose telephone number is (703)-308-2566.

10. Any inquiry of a general nature or relating to the status of the application should be directed to the Technology Center 3600 receptionist whose telephone number is (703)-308-1113.

June 15, 2002



Ed L. Swinehart  
Primary Examiner  
Art Unit 3617